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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91185325
Party	Plaintiff La Senza Corporation
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

LA SENZA CORP., Opposer vs. OLYMPIC MOUNTAIN AND MARINE PRODUCTS, INC., Applicant.	Opposition No. 91185325

OPPOSER'S BRIEF IN REPLY TO
APPLICANT'S MEMORANDUM IN OPPOSITION TO
OPPOSER'S MOTION FOR DISCOVERY UNDER FED. R. CIV. P. 56(F)

Applicant's SJ Motion seeks to summarily deprive Opposer of its opportunity for a full trial on the merits of its likelihood of confusion claim on the basis of three *du Pont* factors. One of the relied upon factors involves the amount and geographic scope of Applicant's sales.

The SJ Motion submitted evidence on Applicant's sales, relying on Applicant's discovery responses. However, after a laborious analysis, Opposer's Rule 56(f) Request demonstrated that Applicant's SJ Motion contained inaccurate and irrelevant information concerning the amount and geographic scope of its sales, and sought discovery related to same. Specifically, Applicant's interrogatory answer – which was expressly relied upon in the SJ Motion – included Applicant's sales to some customers who only operate *outside* of the United States, despite the fact that the interrogatory was expressly limited to the United States. If true, the inclusion of these sales figures in the SJ Motion would inaccurately inflate the relevant sales.

Applicant's response to the Rule 56(f) Request (the "Rule 56(f) Response") concedes that the sales information relied upon and cited in the SJ Motion included sales outside the United States. Moreover, Applicant does not contest – and so concedes – that these non-US sales are irrelevant to the eighth *du Pont* factor. Based on these concessions alone, Opposer respectfully submits that the Rule 56(f) Request has been shown to be meritorious, and should be granted. However, despite Applicant's concessions, Applicant's

Rule 56(f) Response only provides very limited, incomplete and unsubstantiated information regarding its sales, while raising dubious challenges to the Rule 56(f) Request. As a consequence, the Rule 56(f) Request should be granted.

I. Opposer Is Entitled to the Requested Discovery

Applicant contends that it need not respond to the proposed discovery (or amend its inaccurate discovery responses) since it provided *some* information, and that other requested information can be ascertained from the raw data Applicant produced in discovery, if Opposer were "willing to devote the time" to sifting through it. Neither reason justifies Applicant's avoidance of the proposed discovery.

A. Applicant's Supplemental Interrogatory Answer Is Flawed

Oppose's Interrogatory No 2 (first set) – which was served before the SJ Motion was filed – sought, *inter alia*, the amount and geographic scope of Applicant's U.S. sales:

> 2. Identify each product and/or service with which Applicant's mark has been (or is intended to be) used **in the United States**, and with respect to each such product and/or service identify:
>
> . . .
>
> (c) the sales, on an annual basis, in terms of dollar volume and units, of such product and/or service from the date of first use of Applicant's mark in connection with such product and/or service, through the present;
>
> . . .
>
> (e) each state or province in which such product and/or service has been and/or is intended to be sold under or in connection with Applicant's mark.

See Exhibit A to Cuccias Decl., p.15 (emphasis supplied).[1] Applicant's written response, which was extensively supplemented just one day before the SJ Motion was filed, was and remains flatly wrong. First, as Applicant now admits, the answer included Applicant's U.S. and *non-U.S.* sales figures – despite the fact that the interrogatory was expressly limited to the United States. Moreover, the law is clear: sales occurring outside the United States are irrelevant to the present issue – a point Applicant does not contest.

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[1] Applicant characterizes the Rule 56(f) Request as seeking "extensive additional discovery". In fact, the requested discovery largely is based on the discovery Opposer previously served and to which Applicant provided erroneous information. *Compare* Exhibits A and B *with* Exhibits J and K in Cuccias Decl.

Additionally, Applicant's interrogatory answers claimed that each product itemized in its response was sold on a "nationwide" basis. However, Applicant's Rule 56(f) Response acknowledges that it did not sell each itemized product in each state of the United States. Rather, Applicant now blames the "wording" of the interrogatory for its answer: Applicant "intends" to sell each product throughout the United States. However, this explanation is readily contradicted by Applicant's own, earlier interpretation of the interrogatory Applicant offered as a preamble to its supplemental responses:

> "Interrogatory No. 2 of Opposer's First Set of Interrogatories sought information regarding Applicant's sale of products under the ESSENZA mark, including ... [the] geographic regions where each type of product **was sold**".

See Exhibit E to Cuccias Decl., p. 1(emphasis supplied). Thus, Applicant's introduction to its supplemental interrogatory answer demonstrates that Applicant interpreted Interrogatory 2 (first set) as seeking the "geographic regions where each type of product *was sold*", *id.*, not where Applicant "intends" to sell the products.

Moreover, Applicant's explanation (one product may have two different "item numbers", depending on the country in which it will be sold) does not explain why products bearing item numbers sold exclusively REDACTED are listed as having a "nationwide" sales presence in the United States. For example, Applicant's supplemental interrogatories indicate that item numbe had total sales of . *See* Exhibit E to Cuccias Decl., p. 29. However, the total amount sold to a for this same item number is also *See* Exhibit F to Cuccias Decl., A572. Thus, – an entity which does not sell products in the United States – was the only customer for this item number. Despite this fact, item number - sold exclusively in – is listed in Applicant's supplemental responses as having a "nationwide" sales presence in the United States. Accordingly, Opposer is entitled to written discovery responses, as well as supporting documents, concerning the geographic scope of sales.

REDACTED

In any event, the requested discovery overcomes any possible misinterpretation regarding the geographic scope of use – a point which Applicant does not dispute.

B. Applicant's 56(f) Response Provides Insufficient Information

Applicant's 56(f) Response provides a listing of sales to its customers to whom it sold any ESSENZA product (including products not listed in the opposed application) and identifies which customer sells *exclusively* outside of the United States. However, this is not responsive to the earlier interrogatory, and is not enough in view of the arguments proffered in the SJ Motion.

As an initial matter, the sales figures for each client set forth in the body of the Rule 56(f) Response are not referenced or supported in the declaration attached thereto (the "Stice Declaration"). Additionally, the figures in the brief contain no accompanying citation to the record. Moreover, the total sales figure, as tallied in the brief, differs significantly from Applicant's earlier assertions in the SJ Motion – by as much as seven percent (and seems to also differ from the Stice Declaration). Thus, the information contained in the brief is unsupported, of questionable accuracy and, in any event, does not satisfy Opposer's reasonable discovery needs.

Even if the client-specific sales figures (for all products) were credited, it does not clarify the amount of "diffuser products" that were sold in the United States market, which is relevant to the claim raised in the SJ Motion. Indeed, rather than provide this information, which would seem to be readily available to Applicant, Applicant seeks to foist the burden of discovery onto Opposer: "Opposer has been given all of the information needed to identify the type of product sold through each invoice" (emphasis supplied). Such a response is untenable. Forcing a propounding party to scour "each invoice" to determine the other party's sales – especially when relied upon in a potentially dispositive motion – is not what the discovery rules contemplate.

While not stated, it appears that Applicant seeks to rely on Rule 33(d) of the Federal Rules of Civil Procedure to avoid responding to Interrogatory 2 (first set), as well as the proposed discovery. However,

before a responding party can rely on that rule it must establish that, *inter alia*, "the burden of deriving or ascertaining the answer will be substantially the same for either party". Clearly, the burden of ascertaining the relevant information – assuming Opposer can properly interpret the raw data – will not be substantially the same for either party, but weigh far more on Opposer than on Applicant. Accordingly, Rule 33(d) is unavailable to Applicant.

Since it is Applicant's burden to establish the relative burden of ascertaining the answer from the produced materials and since Applicant failed to do so (or even address this issue), Applicant cannot have carried its burden. As a consequence, Applicant may not rely on Rule 33(d). However, and while Opposer does not assume Applicant's burden, Opposer offers the following:

As an initial matter, Applicant produced nearly es of densely-packed sales information (covering a Bates range of A429 - A515 and A538 – A631, excerpts of which were previously submitted by Opposer). Presumably, Opposer would have to interpret and input the information contained in these documents (including, but not limited to, REDACTED

into some form of database. Since the sales summaries do not identify the product by name, Opposer would have to cross-reference this data with some of Applicant's other materials to identify the product – a task apparently complicated by the fact that "some residual inventory was broken up . . . and sold in smaller lots under different item numbers". *See* Exhibit E to Cuccias Decl., p.1. Finally, sales to the customers who have now been identified as non-US sales would have to be filtered out of the overall results. In short, this a laborious and unnecessary task.

On the other hand, this data is already contained within Applicant's database.[3] Thus, the information is, presumably, just a few "clicks" away for Applicant.

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[2] Opposer assumes that the sales figures listed in Applicant's computer report for sales to REDACTED entities are denominated in U.S. dollars, not

[3] Indeed, the produced documents indicate they were derived from a computer program called REDACTED

In short, Applicant ignored, and so failed to establish that, the burden of deriving or ascertaining the answer will be substantially the same for either party. Rather, as Opposer has established (though not its burden), it will be far more burdensome to Opposer to derive or ascertain the answer than it will be for Applicant.

Applicant's "back of the envelope" calculations found in Applicant's brief for Applicant's U.S. sales are not an adequate substitution for an interrogatory answer signed by Applicant. Aside from the evidentiary issues, it is stated in terms of sales of all products in the US, not just those at issue in this proceeding. Based on Applicant's argument, Opposer is entitled to a breakdown of Applicant's U.S. sales by product listed in the opposed application. Moreover, Applicant's calculations in Applicant's Rule 56(f) Response – which appear so precise as to be rounded to the nearest dollar – nevertheless, differ as much as 7% from its earlier assertions.[4]

The Stice Declaration does not provide the required information, either. For example, it only identifies the total amount of all goods (including those not listed in the opposed application) sold to one U.S. customer. Additionally, while the Stice Declaration makes certain claims about the distribution of products through one of its customers, the proposed discovery reasonably requests documents which can substantiate this claim (which is undifferentiated over time). Moreover the Stice Declaration only identifies which customers "do not direct their sales . . . to the REDACTED .[5] Of course, this leaves open the possibility that other of Applicant's customers direct their sales to both the United States market and non-US markets, including some or all of the ESSENZA products. The proposed discovery is directed to this issue, as well.

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[4] Applicant complains that Opposer should have been able to figure out that substantial sales of some ESSENZA products (including irrelevant products) had to be in the U.S. since . of Applicant's claimed U.S. sales were actually made outside of the U.S. Of course, this assumes that Opposer would have known the amount of non-US sales that Applicant originally identified as U.S. sales. In any event, the amount is still over-inflated since it includes goods not at issue in the opposition.

[5] Opposer assumes that the Stice Declaration's reference to the " market refers to the United States market, REDACTED

In short, Opposer established – and Applicant conceded – that Applicant's discovery response identifying Applicant's U.S. sales – evidence relied upon in the SJ Motion – is not accurate and is over-inflated with non-U.S. sales. Applicant does not contest that these non-U.S. sales are irrelevant to the present issue. However, Applicant refuses to provide the requested information, instead seeking to foist this burdensome task onto Opposer – despite the demonstrated inapplicability of Fed.R.Civ. Pro. 33(d).

II. Opposer's Rule 56(f) Request Is Timely Filed; Not "Dilatory" or "Last Minute"

Applicant seeks to characterize the Rule 56(f) Request as "dilatory" and "last minute". Patently, Applicant is wrong. As Applicant admits, the Rule 56(f) Request met the deadline set by the Board for filing a response to the SJ Motion. On this basis alone, the Rule 56(f) Request was not "dilatory" or "last minute", but rather timely filed.

Similarly, Applicant's claim that Opposer should have filed the Rule 56(f) Request "months ago" also is wrong since the briefing on the SJ Motion was suspended by the Board shortly after the filing of the SJ Motion. As the record shows, Applicant's initial discovery responses contained "omissions and errors", *see* Exhibit E to Cuccias Decl., and were supplemented and additional documents produced on September 30, 2009. The *very next day*, October 1, 2009, Applicant filed the SJ Motion, effectively suspending the matter (however, Applicant did not serve Opposer with a complete copy until one week later). Before any response to the SJ Motion was due, the Board issued an Order suspending the briefing schedule on the SJ Motion in order to first address Applicant's Motion to amend. Thus, the simple answer to Applicant's question of "why this discovery was not sought at any point since the S.J. Motion was filed" is that it would have been premature.[6]

[6] Applicant suggests that this issue could have been resolved by a couple of informal telephone calls. However, when Applicant's formal responses to Opposer's written discovery are so plainly wrong, why would Opposer rely on a few "phone calls"? More to the point, such "phone calls" do not constitute competent evidence.

III The Proposed Discovery Is Not Burdensome

The final section of Applicant's Rule 56(f) Response claims that the proposed discovery is "highly burdensome".[7] However, with the exception of one interrogatory *sub-part*, namely, Interrogatory 1(f) (proposed set), Applicant fails to identify the discovery request(s) thought to be "highly burdensome" and the reasons therefor. Accordingly, Applicant's "burdensome" argument is limited to this single interrogatory sub-part.

Moreover, even as to Interrogatory 1(f) (proposed set), Applicant fails to explain why it is "highly burdensome". Rather, Applicant argues that it is "unnecessary" in view of the information disclosed *for the first time* in the declaration attached to the Rule 56(f) Response (the sufficiency of which is discussed above). For this reason, Applicant's contention that the discovery is "highly burdensome" should be rejected. As to the necessity of Interrogatory 1(f) (proposed set), it is intended for the very narrow purpose of discovering information significant to the claims made in the SJ Motion regarding the amount and geographic scope of Applicant's sales in the relevant market. These requests – which Applicant admits "Opposer has been careful to specify" – have become necessary given the inaccurate information previously disclosed in discovery and the continued refusal to provide the information.

Finally, Applicant's arguments are inconsistent. One the one hand, Applicant contends that the proposed discovery is "highly burdensome" (but fails to explain why); yet on the other hand, Applicant contends that the proposed discovery is unnecessary because Opposer has all of the information necessary to ascertain the requested information. Applicant cannot have it both ways.

In any event, having spent an inordinate amount of time uncovering Applicant's erroneous interrogatory responses that were relied upon in the SJ Motion – a burden Opposer should not have had to

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[7] It is noted that much of the proposed discovery is based on the discovery Opposer originally served, but to which Applicant gave inaccurate (or confused) answers.

undertake given the express terms of the interrogatory – any "burden" in ascertaining the requested information should be borne by Applicant.

Conclusion

In sum, Opposer respectfully requests that Applicant be ordered to provide discovery on its sales volume and the geographic scope of use of the mark within the United States. Applicant admits that Opposer's discovery was directed to U.S. sales and that Applicant's answers – relied upon in the SJ Motion – includes sales outside of the United States. Applicant does not contest that the non-U.S. sales are irrelevant to the present issue. However, Applicant still refuses to identify that sales volume – leaving it to Opposer to figure it out, if Opposer is "willing to devote the time".[8] Moreover, Applicant does not contest the relevance of the requested information, and its objections are without merit. As previously noted, while Opposer does not agree that the eighth *du Pont* factor is relevant to the likelihood of confusion analysis, since Applicant has posited the argument, Opposer should be entitled to discovery regarding same.

Accordingly, Opposer respectfully requests that the Board grant its requests for discovery under Rule 56(f), and that a ruling on Applicant's Motion for summary judgment be continued pending further opportunity for discovery by Opposer.

Respectfully submitted,

LA SENZA CORP.

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[8] Applicant argues that the Rule 56(f) Request should be "weighed against the background of its thorough cooperation". While there is no "contextual" requirement found in Rule 56(f), in view of the above, it is somewhat ironic that Applicant would seek to cast its "cooperation" as a basis for denying the Rule 56(f) Request.

CERTIFICATE OF SERVICE

I hereby certify that I have caused a true and correct copy of the foregoing OPPOSER'S BRIEF IN REPLY TO APPLICANT'S MEMORANDUM IN OPPOSITION TO OPPOSER'S MOTION FOR DISCOVERY UNDER FED. R. CIV. P. 56(f), to be served by first-class mail, postage prepaid, upon counsel for Applicant:

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on this 7th day of October, 2010